

### Remarks

This is in response to the Office Action mailed September 8, 2004. The Applicant has hereinabove amended the title of the application to better conform to the claimed subject matter. This amendment is proper, does not introduce new matter, and serves to place the application in better condition for reconsideration and allowance.

### Restriction/Election Requirement

The Examiner failed to examine claim 15 along with the elected claims 1-7 of Group I. The Applicant requests reconsideration of the finding by the Examiner that claim 15 is not a proper linking claim between the inventions of Group I (claims 1-7) and Group II (claims 8-14). The Applicant maintains that claim 15 is a proper linking claim that links the product of independent claim 8 with the method of claim 1, and therefore should be examined along with the elected claims 1-7.

The Examiner correctly noted that claim 15 is a product-by-process claim. According to MPEP 809.03(B), this would be an appropriate basis to identify this claim as a linking claim ("The most common types of *linking claims* which, if allowed, act to prevent restriction between inventions that can otherwise be shown to be divisible, are...(B) *a claim to the necessary process of making a product linking proper process and product claims...*" MPEP §809.03).

Claim 15 is "a claim to the necessary process of making" the product of claim 8 by way of the "steps for" element which, when properly construed in accordance with 35 U.S.C. §112, sixth paragraph, encompasses the steps listed in method claim 1. See *In re Donaldson Co. Inc.*, 29 USPQ2d 1845 (Fed. Cir. 1994)(*en banc*); *Seal-Flex, Inc. v. Athletic*

*Track and Court Construction*, 50 USPQ2d 1225 (Fed. Cir. 1999); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112 Para. 6*, 65 FR 38510.

According to MPEP 809, "linking claims *must be* examined with the invention elected, and should any linking claim be allowed, the restriction requirement *must be* withdrawn." See also 37 CFR 1.141(b).

Thus, since the Examiner has stated that claim 15 is a product-by-process claim, and since it clearly links the respective inventions of Group I and II, the Examiner is obliged to examine it along with the elected claims, as well as to examine the non-elected claims upon allowance of claim 15.

Accordingly, the Applicant requests reinstatement and examination of claim 15 along with the elected claims 1-7.

#### **Rejection of Claims Under 35 U.S.C. §103**

The Office Action rejected claims 1-7 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,214,549 issued to Baker et al. ("Baker '594") in view of U.S. Patent No. 5,520,052 issued to Pechersky ("Pechersky '052"). This is respectfully traversed.

First, there is nothing to support the Examiner's contention that one skilled in the art would be motivated to add additional rigid damping layers and visco-elastic layers to the structure of Baker '549 as a mere duplication of parts for a multiplied effect. Unlike in *St. Regis Paper Co.*, (193 USPQ 8 (7<sup>th</sup> Cir. 1977)), one having skill in the art would not expect such "multiplied effect" (improved damping, etc.) to take place.

As discussed in the specification at page 8, lines 1-15, it is not possible to *a priori* predict the response of additional layers to the structure of Baker '549; indeed, it has been found that such additional layers can actually *degrade* the damping characteristics of the structure. The Examiner's contentions concerning merely adding additional layers to Baker '594 in view of *St. Regis Paper Co.* are thus inapposite.

The Examiner is correct in stating that Baker '549 is deficient in determining a resonant frequency of a housing structure (multi-layer or otherwise), ascertaining a loss factor profile and selecting a final characteristic of each of the layers in relation to the ascertained loss factor profiles. Perchersky '052 fails to make up for these (and other) deficiencies of Baker '549.

The method taught by Perchersky '052 for determining a damping loss factor for a particular material adds nothing of particular significance to the claimed combination. Both Perchersky '052 and Baker '549, as well as the other art of record, are silent with regard to, *inter alia*, ascertaining a loss factor in relation to the resonant frequency *for each of a plurality of hypothetical models* for the housing structure, each model comprising first, second and third *theoretical layers* wherein at least one of said theoretical layers comprises *multiple damping layers*, as set forth by elected claims 1 and 15.

It is therefore respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness by mischaracterizing the teachings of the respective references, by failing to account for all of the limitations of the claim, and, to the extent that limitations in the claim have been accounted for, by engaging in hindsight reconstruction using the claim language as a blue print to arrive at the claimed combination.

Reconsideration and withdrawal of the rejection of claims 1-7, and examination and allowance of linking claim 15, are therefore requested.

### Conclusion

This is intended to be a complete response to the Office Action mailed September 8, 2004. The Applicant respectfully requests reconsideration and allowance of elected claims 1-7, examination of linking claim 15 and, in view of the allowance thereof, examination and allowance of claim 16 and non-elected claims 8-14.

Should any questions arise concerning this response, the Examiner is invited to contact the below listed Attorneys.

Respectfully submitted,

By: 

Randall K. McCarthy, Registration No. 39,297  
Mitchell K. McCarthy, Registration No. 38,794  
Fellers, Snider, Blankenship, Bailey and Tippens, P.C.  
Bank One Tower  
100 N. Broadway, Suite 1700  
Oklahoma City, Oklahoma 73102  
Telephone: (405) 232-0621  
Facsimile: (405) 232-9659  
Customer No. 33900